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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAI HUANG, THOMAS WALTER KELLER, JR., and
ERIC VAN HENSBERGEN

Appeal 2008-005965
Application 10/727,319
Technology Center 2100

Decided: January 22, 2010

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The Patent Examiner rejected claims 1, 3-11, 13-15, and 18-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

The invention at issue on appeal relates generally to power management in processing systems and more particularly to a power management scheme that includes an intelligent device controller providing local control of device power management states. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A device controller for coupling one or more controlled devices to one or more processors in a processing system, comprising:

a command unit for sending commands to said one or more devices;

at least one usage evaluator having an input coupled to an output of said command unit for evaluating a frequency of use of an associated controlled device;

control logic coupled to said usage evaluator and further coupled to an input of said command unit for sending power management commands in response to said usage evaluator detecting that a usage level of said associated device has fallen below a threshold level, whereby said device controller power manages said controlled device without intervention by said one or more processors;

an output port coupled to said at least one usage evaluator for reading a state of said at least one usage evaluator, whereby a state of said at least one usage evaluator may be stored external to said device controller; and

an input port coupled to said at least one usage evaluator for setting a state of said at least one usage evaluator, whereby said state

of said at least one usage evaluator may be restored from information stored external to said device controller.

C. REFERENCES

The Examiner relies on the following references as evidence:

Faucher	US 5,404,543	Apr. 4, 1995
Fleck	US 6,128,641	Oct. 3, 2000

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1, 3, 10 and 11 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 8-10, 16 and 18-19 of copending Application No. 10/727,320 (hereinafter referred to as '320), now US Patent 7,155,623, in view of Faucher.

Claims 1, 3-11, 13 and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Faucher.

Claims 15 and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Faucher in view of Fleck.

II. ISSUE

Have Appellants shown error in the Examiner's initial showing of obviousness-type double patenting? Have Appellants shown error in the Examiner's initial showing of anticipation and obviousness?

III. PRINCIPLES OF LAW

Obviousness-type double patenting

The issue to consider when determining whether a non-statutory basis exists for a double patenting rejection is whether any claim in the application defines an invention that is merely an obvious variation of an invention claimed in another patent.[1] The analysis employed in an obviousness-type double patenting determination parallels the guidelines for an obviousness determination under 35 U.S.C. § 103(a). *In re Braat,* 937 F.2d 589, 593-94 (Fed. Cir. 1991); *see also In re Longi,* 759 F.2d 887, 892 n.4 (Fed. Cir. 1985).

35 U.S.C. § 102

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.,* 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

[1] In this case, since the application at issue was filed later than the Moody patent, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application would have been an obvious variation of the invention defined in a claim in the patent. M.P.E.P. § 804 (August 2001).

art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990) (citation omitted)). The properly interpreted claim must then be compared with the prior art.

Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

IV. FINDINGS OF FACT

1. Claims 16-20 in U.S. patent application 10/727,320 were canceled in the Amendment dated September 26, 2006.

V. ANALYSIS

Obviousness-Type Double Patenting

The Examiner rejected independent claim 1 and dependent claim 3 relying upon canceled claims 16 and 18 of the co-pending application '320. Since these claims were no longer pending claims, a double patenting rejection cannot be based upon non-existing claims. There is no "double" patenting, but only "single" patenting. Therefore, we dismiss the Examiner's rejection to the extent that it relies upon canceled claims.

With respect to independent claim 10 and dependent claim 11, the Examiner relies upon claims 8 and 9 of the co-pending application '320. While these claims have been allowed/patented (US Patent 7,155,623), we note that the Examiner has not done a thorough comparison of the instant claims against the patented claims, nor has the Examiner expressly identified the required "input port" and "output port" as required by the language of independent claim 10. Additionally, we note that Appellants at page 12 of the Brief have identified that the Examiner erred in rejecting claims relying upon canceled claims in the obviousness-type double patenting rejection. However, the Examiner again repeats the same rejection at pages 4-5 of the Answer and summarily dismisses Appellants' arguments in the responsive arguments at page 25 of the Answer. We find the Examiner's treatment of the claims under obviousness-type double patenting falls short of setting

forth a proper initial showing of obviousness-type double patenting which is sustainable on review.

Appellants have shown error in the Examiner's obviousness-type double patenting rejection of claims 1, 3, 10, and 11.

35 U.S.C. § 102

Appellants contend that "Faucher does not disclose an output port and input port for reading and setting a state of the usage of evaluator so that the state can be stored and restored external to the device controller." (App. Br. 6). Appellants further contend that "[t]he structure described in Faucher does not enable preservation of such usage evaluator state information and Faucher does not describe any such action nor include an input and output port that enable such action with respect to the state of the usage evaluators." (App. Br. 6). We agree with Appellants' interpretation of the teachings of Faucher and look to the Examiner's Answer to respond to Appellants' contentions.

We find the Examiner's stated rejection essentially repeats the text of the Final Rejection. We next turn to the Examiner's responsive arguments at pages 19-24 of the Answer. While the Examiner's responsive argument section appears impressive with the use of its figures, we find the Examiner's figure 3 on page 22 misrepresents the express teachings of Faucher. Additionally, we find the "Response to Argument" section falls short of responding to Appellants' arguments since this section merely restates the Examiner's correlation and does not directly address Appellants' arguments and contentions.

Specifically, Faucher in figure 3 does not show any input or output ports nor has the Examiner expressly stated that Faucher "inherently" teaches an "input port" and an "output port," and that these ports are used to store and restore states from an external storage. As an additional discontinuity between the Examiner's correlation, we note the Examiner has identified the Programmable Memory Power System 24 as the external storage in figure 2, yet the Examiner has identified the amended figure 3 input port and output port as the path for communication to the external memory for saving the state of usage evaluator's then restoring the stored states to the device controller. In the amended figure 3, these ports do not communicate with Programmable Memory Power System 24. Therefore, the Examiner does not provide an adequate basis for a showing of anticipation based upon the Faucher reference. Therefore, we find the Examiner's discussion of the input port and the output port at pages 21 and 22 of the Answer to be based upon speculation rather than the express teachings of the Faucher reference. Therefore, we find that Appellants have shown error in the Examiner's initial showing of anticipation of independent claim 1 and dependent claims 3-9.

We find independent claim 10 contains corresponding limitations to the input port and output port which are lacking in the teachings of the Faucher reference. Therefore, we cannot sustain the Examiner's rejection of independent claim 10 and dependent claims of 11, 13 and 14.

Obviousness

With respect to independent claim 15, Appellants rely upon similar arguments above concerning the storing and restoring the state information,

and that the combination of Faucher and Fleck does not disclose or suggest a device controller having input and output ports for saving state of the usage of evaluators (App. Br. 11) or the "state of said evaluating" as recited in independent claim 15.

The Examiner in the statement of the rejection merely repeats the claim language and cites to the Summary of the Invention in Fleck and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the power managing method of Faucher to include saving and recovering of the contexts switch as taught by Fleck to arrive at the claimed invention. (Ans. 17). We disagree with the Examiner's sweeping conclusion and find that the teachings of Fleck are directed to basic interrupt processing and are not as readily interchangeable with the teachings of Faucher as the Examiner appears to apply them.

Rather, we find the Examiner has not set forth sufficient initial showing of obviousness of the invention as recited in independent claim 15 and its dependent claims 18-20.

VI. CONCLUSION

For the aforementioned reasons, Appellants have shown error in the Examiner's initial showing of obvious-type double patenting. Appellants have shown error in the Examiner's initial showing of both anticipation and obviousness.

VII. ORDER

We reverse the provisional rejection of claims 1, 3, 10 and 11 on the ground of non-statutory obviousness-type double patenting. We reverse the

anticipation rejection of claims 1, 3-11, 13, and 14, and we reverse the obviousness rejection of claims 15 and 18-20.

REVERSED

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